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EXAMINER

CHANNAVAJALA, LAKSHMI SARADA

ART UNIT	PAPER NUMBER
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1611

MAIL DATE	DELIVERY MODE
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07/01/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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DETAILED ACTION

Receipt of response dated 3-30-09 is acknowledged.

Claims 1-64 are pending in the instant application.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-64 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-130 of U.S. Patent No. 6811770.

Although the conflicting claims are not identical, they are not patentably distinct from each other. Instant claims recite a two-composition product comprising a first composition with a liquid fatty phase with polymer particles dispersed in there and a second composition comprising a polymer of high molecular weight. Instant claims also

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recite a method of applying the composition to the skin and a kit. The patented claims recite a process of applying a cosmetic composition to the skin or lips comprising a first coat made of a dispersed polymer in a liquid fatty phase and a surface stabilizer, and a second composition comprising silicon or fluoro based liquid phase. The polymers dispersed in first phase, their amounts, the surface stabilizer, other excipients such as wax, gelling agents, the particle size of dispersed polymers and the compounds of the second composition described in the patented claims are also described in the instant claims and therefore the patented claims anticipate the instant composition, kit and the method of applying the composition.

Response to Arguments

3. Applicant's arguments filed 3-30-09 have been fully considered but they are not persuasive.
4. Applicants argue that in double patenting it is well established that the comparison must be done between the claims of an issued patent and the claims of a pending application. See MPEP § 804.03. It is argued that Ferrari's claims do not expressly teach or suggest including in the second composition any polymers having an average molecular weight of greater than or equal to 200,000 g/mol, as presently claimed. It is argued that most of the silicone-based and/or fluoro-based liquid phases as claimed in Ferrari have an average molecular weight of lower than 200,000 g/mol. Applicants' arguments are not persuasive because Ferrari teaches a two coat composition, where the first phase is the same as that of the instant claims i.e., polymer

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particles in a liquid fatty phase and the polymer particles formed from monomers and are stabilized at their surface by at least one stabilizer. In response to the argument that double patenting is between claims, the examiner made a comparison of only instant claims with that of the patented claims. The claims of Ferrari fail to recite high molecular weight polymers. Applicants argue that the dependent claim 48 recite a molecular weight that is lower than claims. However, the dependent claims of the patent also recite high viscosities, applicants have not shown any evidence that the silicones, particularly, those having high viscosity (as high as 100000 cst claimed in the patent) do not possess the claimed molecular weight. Applicants argue that the high molecular weight gelling agent of the dependent claims are included in the first and not the second composition of the patented composition. With respect to this argument, instant claims, except that of claim 62, do not require that the compositions be separated and accordingly, even if the claims recite first and second compositions, the two being in the same product are not distinct. Thus, the high molecular weight gelling agents also read on the instant high molecular weight silicones.

Claim Rejections - 35 USC § 102

5. Claims 1-64 rejected under 35 U.S.C. 102(e) as being anticipated by US PGPUB 2003/0039621 to Arnaud et al OR over US 6811770.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome

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either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

6. Arnaud discloses a cosmetic make-up product containing a first and a second composition, the first composition comprising, in a physiologically acceptable medium, dispersed polymer particles surface-stabilized with a stabilizer in a liquid organic phase and a coloring agent, and the second composition comprising a second physiologically acceptable medium (abstract). The compositions may be packaged together or separately (0026). The composition is applied as a base coat and then as a top coat to the composition (0029). The composition is suitable for application as a makeup for face, lips, eyeliners, hair care etc. (page 2). For the polymer dispersion, Arnaud teaches polymer nanoparticles of 5 nm to 800 nm (0049) and a molecular weight of 2000 to 10,000,000 (0051). The first composition of Arnaud comprises polymer particles in dispersion, which is soluble in the liquid organic phase or fatty phase (paragraph 0044). Film-forming polymers may be used (paragraph 0054). The amount of polymer may be greater than 2% by weight (paragraph 0045). Examples of film forming polymers include polyurethanes, polyurethane-acrylics, polyureas, polyurea-polyurethanes, polyester-polyurethanes, polyether-polyurethanes, polyesters, polyesteramides, alkyd fatty-chain polyesters; acrylic and/or vinyl polymers or copolymers; acrylic-silicone copolymers; polyacrylamides; silicone polymers, for instance silicone acrylics or polyurethanes, fluoro polymers, and mixtures thereof (paragraph 0072). For the stabilizer, Arnaud teaches random block or graft polymers (0075-0089). The compositions may be in

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anhydrous form (paragraph 0225), or each composition may have the appearance of a lotion, cream, ointment, soft paste, salve, a cast or molded solid, or a more or less rigid stick (paragraphs 0226-0227). For the liquid fatty phase, Arnaud describes several oils both volatile and non-volatile (0103- 0105) and in an amount of 20-90%. For the thickeners, Arnaud teaches gelling agents (0115). Arnaud further teaches adding wax, fillers, coloring agents etc (0116-0139). For the second composition, Arnaud teaches liquid phase (0151-0156, 0168), in particular, the fluorosilicone compound of formula I (0169), which reads on the instant polymer of second composition and other silicone compounds (170+). Further, the examples show the two compositions described by Arnaud. Therefore, Arnaud anticipates instant claims.

7. The teachings of US 6811770 are described in the previous paragraphs. The composition of 6811770 also employs the instant claimed first and second compositions, with the same polymer particles in the first phase and the silicone polymers that make up the second phase. Therefore, US 681170 anticipate instant claims.

Response to Arguments

8. Applicant's arguments filed 3-30-09 have been fully considered but they are not persuasive.

9. Applicants agree that Arnaud teaches first and second compositions but argue that Arnaud fails to disclose molecular weight information on most of these phases in the second composition, let alone a "high molecular weight polymer having a weight-average molecular mass of greater than or equal to 200,000g/mol", as recited in the

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present claims. It is argued that Arnaud teaches that the fluoro polyethers have the weight-average molecular weight ranging from 500 to 100,000 and preferably from 500 to 10,000. See paragraph [0182]. Instant claim 1 does not require that the high molecular weight to be a silicone polymer and therefore any high molecular weight polymer employed by Arnaud, including the lipophilic gelling agent [0121] of Arnaud reads on the claimed high molecular weight polymer of claims 1, 59, 60, 63 and 64. Further, with respect to the argument that the fluorosilicone of Shin Etsu do not possess the claimed molecular weight, applicants did not show evidence that the fluoro silicones such as x22 819 do not possess high molecular weight. Whereas US patent 5637306 describes high molecular weight silicones between 200000 and 1,000,000 that includes the fluoro silicone described by Arnaud i.e., X-22-819 (col. 2, 43- col. 3, L 38). While it is true that Arnaud also describes other silicone polymers that may be of low molecular weight, Arnaud's teachings are not limited to low molecular weight silicones.

10. With respect to applicant's arguments that the examiner contends that the first composition of Arnaud reads on instant second composition, examiner nowhere equated first and second compositions of Arnaud with instant second and first respectively, and explained the high molecular weight polymers.

11. Applicants argue that similar to Arnaud, Ferrari is silent on the molecular weight of most of the disclosed silicone-based and/or fluoro-based compounds in the second compositions, and only discloses that the fluoro compounds have the weight-average molecular weight ranging from 500 to 100,000 and preferably from 500 to 10,000.

However, the argument is not persuasive because Ferrari also teaches the specific

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fluorosilicone polymers such as X22-819, 820 etc., which according to US patent 5637306 are high molecular weight silicones (between 200000 and 1,000,000). Both Ferrari and Arnaud teach other silicone polymers that possess the low molecular weights, other than X22-819, 820 and thus the list of silicone polymers of Arnaud or Ferrari are not limited to low molecular weight compounds.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S. Channavajjala whose telephone number is 571-272-0591. The examiner can normally be reached on 9.00 AM -5.30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila G. Landau can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lakshmi S Channavajjala/
Primary Examiner, Art Unit 1611
June 21, 2009